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HALIM, SAHERA				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/579,393

Applicant(s)

KRIKORIAN ET AL.

Examiner

SAHERA HALIM

Art Unit

2457

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 February 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-26 and 28-58 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-26 and 28-58 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
Paper No(s)/Mail Date: _____

DETAILED ACTION

1. This Office Action responsive to amendment filed on February 6, 2009.
2. Claims 1-3, 5-26, 28-58 are pending.
3. Claims 4 and 27 have been cancelled.
4. Claim 58 has been added.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-11, 13-20, 22-23 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim scope is not limited by claim language that suggests or makes optional but does not require steps to be performed, or by claim language that does not limit a claim to a particular structure. However, examples of claim language, although not exhaustive, that may raise a question as to the limiting effect of the language in a claim are:

- (A) statements of intended use or field of use;
- (B) "adapted to" or "adapted for" clauses;
- (C) "wherein" clauses; and
- (D) "whereby" clauses.

The determination of whether each of these clauses is a limitation in a claim depends on the specific facts of the case. In *Hoffer v. Microsoft Corp.*, 405 F.3d 1326, 1329, 74 USPQ2d 1481, 1483 (Fed. Cir. 2005), the court held that when a "whereby" clause states a condition that is material to patentability, it cannot be ignored in order to change the substance of the invention." *Id.* However, the court noted (quoting *Minton v. Nat'l Ass'n of Securities Dealers, Inc.*, 336 F.3d 1373, 1381, 67 USPQ2d 1614, 1620 (Fed.Cir. 2003)) that a "whereby" clause in a method claim is not given weight when it simply expresses the intended result of a process step positively recited." *Id.* (*MPEP*, sections 2106 and 2111.04)

The claims listed above (dependent claims inherit the rejection from the independent claims) all recite "operably connectable " and/or "configured to" clauses, which are non-limiting in scope and therefore should be corrected in order to clearly specify the metes and bounds of the claimed invention and to define the inventive steps performed by the claimed elements.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-3, 14-18, 21, 24-26, 37-41, 44, and 47-52 and are rejected under 35 U.S.C. 102(e) as being anticipated US Pat. No. 6,389,467 to Eyal (hereinafter Eyal).

8. Regarding claim 1, Eyal teaches a continues media playback system controlled over a distributed communication system comprising (abstract):

at least one playback control device located at a playback location (see Fig. 2, 210), the at least one playback control device operably connectable to said distributed communications system and including an output device (Fig. 2, 210 and 212; the viewer is connected to 200 through 212), memory to store digital media files and a continues play program (see col. 13, line 46 – 52 and col. 16, line 1-5; continuous play list), and a controller to control the output of said digital media files to said output device according to said continuous play program, wherein said digital media files

include at least one media file of a type selected from the group consisting of audio, video, and announcement (see col. 11, line 19 – 37, Fig. 22, and col. 38, line 5-9; audio, video and movie clips, movie trailers or highlights from sporting events);

wherein said playback location is remotely located from a computer that is configured to communicate with said distributed communications system (see Fig. 2; 210 is remotely located);

wherein said computer is operably connectable to a remotely located web server (Fig. 2, 280) via said distributed communications system, said web server for serving digital media files from a master library (Fig. 2, 220 and 245), wherein said computer includes a user interface configured to allow a playback manager to access said web server via said distributed communications system to modify said continuous play program for each playback control device (see col. 12, line 41 – 67; editor edits meta data of playlist and col. 26. line 9-67; editor software interface and module); and

wherein said computer is provided with one or more executable files from said web server to allow said playback manager to select one or more media files for audition without affecting said continuous play program (see col. 25, line 44-58 media is played back to editor and col. 10, line 64 – col. 11, line 17).

9. Regarding claim 24, Eyal teaches a method of programming at least one playback control device located at a playback location in a continuous media playback system controlled over a distributed communication system, the method comprising (abstract):

accessing a web site via the distributed communications system using a user interface of a computer including a web browser, the computer located remote from said web site and remotely located from said playback location (see Fig. 2, the playback 210 device access the web server 280);

accessing and arranging at least one of digital media files and predetermined collections of said digital media files to create or modify a continuous play program for said playback control device via said web site (see Fig. 2, the playback device 210 is able to customize the playlist) , wherein said media files include at least one file of a type selected from a group including audio, video and announcements (see col. 11, line 19 – 37, Fig. 22, and col. 38, line 5-9; audio, video and movie clips, movie trailers or highlights form sporting events); and

permitting a user to access one or more digital media files using said user interface to audition the one or more digital media files without affecting the continuous play program (col. 29, line 1-37; the user is able to select and rate media of the playlist).

10. As per claims 2 and 25, Eyal teaches the continuous media playback system and method of claims 1 and 24 wherein said computer is configured to include a browser module for accessing said web server and wherein said web server is configured to transmit executable files to said computer for creating said continuous play program (see col. 25, line 44-58 media is played back to editor and col. 10, line 64 – col. 11, line 17).

11. Regarding claim 3 and 26, Eyal teaches the continuous media playback system and method of claims 2 and 25, wherein said executable files are at least one of Active-X components, Java Applets and Java Script (see col. 11, line 3-17).

12. As per claim 14 and 37, Eyal teaches the continuous media playback system and method of claims 2 and 25 wherein said executable files are configured to allow said computer to access continuous play programs for a plurality of said playback control devices (see summary).

13. As per claims 15 and 38, Eyal teaches the continuous media playback system and method of claims 14 and 24 wherein said executable files are configured to allow said computer to group at least two of said playback control devices and to create a common continuous play program for said at least two of said playback control devices (see summary).

14. As per claims 16 and 39, Eyal teaches the continuous media playback system and method of claims 2 and 25, wherein said executable files allow said computer to display a digital media file that is currently being played by said playback control device and at least one digital media file that follows said digital media file that is currently being played (see col. 30, line 11 – 67).

15. As per claims 17 and 40, Eyal teaches the continuous media playback system and method of claims 16 and 24, wherein said web server delivers at least one digital media file to said computer as a streaming media file for output to said output device connected to said computer (see Fig. 2 and col. 13, line 40 – col. 14, line 67).

16. As per claims 18 and 41, Eyal teaches the continuous media playback system and method of claims 1 and 24 wherein said web server is configured to store a profile for said playback control device (col. 26, line 50 – col. 27, line 30).

17. As per claims 21 and 44 Eyal teaches the continuous media playback system and method of claims 2 and 24 wherein said master library further comprises at least one file of type selected from the group including digital announcement files, video files, and text/graphics files (column 11, line 5 – line 45).

18. As per claims 47 and 49, Eyal teaches the continuous media playback system of claims 1 and 24 wherein the computer alters the play programs for a plurality of playback control devices (see summary).

19. As per claims 48 and 50, Eyal teaches the continuous media playback system of claim 1 wherein said computer groups at least two of said playback control devices and creates a common continuous play program for said at least two of said playback control devices (see Fig. 20 and col. 34, line 5 - 67).

20. As per claim 51 and 52, Eyal teaches the continuous media playback wherein each playback control device includes a master library of digital files (see Fig. 2).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5, 28, and 53-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eyal in view of Martin US. Pat. No. 6,970,834 (hereinafter Martin).

21. As per claims 5 and 28 Eyal teaches the continuous media playback system and method of claims 2 and 24. Eyal does not teach wherein said executable files are configured to allow said computer to select and arrange custom play lists by selecting a plurality of said digital media files from said master library and by allowing at least one of sequencing said digital media files and randomly playing said digital media files.

Martin teaches wherein said executable files are configured to allow said computer to select and arrange custom play lists by selecting a plurality of said digital media files from said master library and by allowing at least one of sequencing said digital media files and randomly playing said digital media files (Fig. 5 and col. 7, line 29 – col. 8, line 23).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine the random selection of Martin with the files of Eyal. A person of ordinary skill in the art would have been motivated to do this because it would increase system flexibility thus enhancing user stratification.

22. As per claims 53 and 55, Eyal does not teach wherein said executable files permit said computer to control playback volume for said continuous play program. However, Martin teaches controlling playback volume for said continuous program (col. 5, line 28 - col. 6, line 67). It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine the conventional limitation of controlling playback volume of Martin with the end user of Eyal. A person of ordinary skill in the art would have been motivated to do this because it would increase system flexibility; thus enhancing user stratification.

23. As per claims 54 and 56, Eyal does not teach wherein said controlling playback volume comprises controlling playback volume as a function of at least one parameter selected from the group consisting of: time, type of location, and area within a type of location. However, Martin teaches said controlling playback volume comprises controlling playback volume as a function of at least one parameter selected from the group consisting of: time, type of location, and area within a type of location (col. 5, line 28 - col. 6, line 67)

See motivation for claims 53 and 55.

24. Claims 6-13, 29-36, 19, 20, 22-23, 42-43, 45-46, and 57-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eyal in view of Krikorian US Patent No. 5,726,909.

25. As per claims 6 and 29, Eyal teaches the continuous play broadcast system of claims 2 and 25. Eyal does not teach wherein said executable files allow said computer to select a plurality of predetermined collections of said digital media files, to allocate percentages of time for playing said collections and to create a composite collection that randomly selects said digital media files from said collections based on said allocated percentages. Krikorian teaches wherein said executable files allow said computer to select a plurality of predetermined collections of said digital media files, to allocate percentages of time for playing said collections and to create a composite collection that randomly selects said digital media files from said collections based on said allocated percentages (column5, lines 33-43).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine the teachings of Eyal, Martin and Krikorian. A person of ordinary skill in the art would have been motivated to do this because it would increase system flexibility; thus enhancing user stratification.

26. As per claims 7 and 30, Eyal teaches the continuous play broadcast system of claims 6 and 29. Eyal does not teach wherein said executable files allow said computer

to select at least one of said digital media files within said predetermined collections and to adjust the frequency at which said at least one of said digital media files is played in said composite collection. Krikorian teaches wherein said executable files allow said computer to select at least one of said digital media files within said predetermined collections and to adjust the frequency at which said at least one of said digital media files is played in said composite collection (column 5, lines 44-50).

See motivation for claim 6.

27. As per claims 8 and 31, Eyal teaches the continuous play broadcast system and method of claims 6 and 29, wherein said executable files allow said computer to select at least one of said digital media files within said predetermined collections and to prevent said at least one of said digital media files from playing in said composite collection (see col. 26, line 48 – 67).

28. As per claims 9 and 32, Eyal teaches the continuous play broadcast system and method of claims 6 and 29. Eyal does not teach wherein said executable files allow said computer to select at least one of said digital media files within said predetermined collections and to prevent said at least one of said digital media files from playing during preselected times in said composite collection. Krikorian teaches wherein said executable files allow said computer to select at least one of said digital media files within said predetermined collections and to prevent said at least one of said digital

media files from playing during preselected times in said composite collection (column 5, line 51-67).

See motivation for claim 6.

29. As per claims 10 and 33, Eyal teaches the continuous play broadcast system and method of claims 6 and 29. Eyal does not teach wherein said executable files allow said computer to assign said predetermined collections to a time-based schedule that forms part of said continuous play program. Krikorian teaches wherein said executable files allow said computer to assign said predetermined collections to a time-based schedule that forms part of said continuous play program (column 6, lines 36-64).

See motivation for claim 6.

30. As per claims 11 and 34, Eyal teaches the continuous play broadcast system and method of claims 10 and 33. Eyal does not teach wherein said executable files allow said computer to assign said composite collection to said time-based schedule. Krikorian teaches wherein said executable files allow said computer to assign said composite collection to said time-based schedule (column 6, lines 36-64).

See motivation for claim 6.

31. As per claims 12 and 35, Eyal teaches the continuous play broadcast system and method of claims 10 and 33. Eyal does not teach wherein a smallest time unit provided

in said time-based schedule can be varied. Krikorian teaches wherein a smallest time unit provided in said time-based schedule can be varied (column 6, lines 36-64).

See motivation for claim 6.

32. As per claims 13 and 36, Eyal fails to teach the continuous play broadcast system and method of claims 12 and 24 wherein said executable files allow said computer to select and arrange custom collections by allowing at least one of selecting a plurality of said digital media files from said master library and by sequencing said digital media files and randomly playing said digital media files. However, Krikorian teaches the continuous play broadcast system and method of claims 12 and 24 wherein said executable files allow said computer to select and arrange custom collections by allowing at least one of selecting a plurality of said digital media files from said master library and by sequencing said digital media files and randomly playing said digital media files (column 6, lines 36-64).

See motivation for claim 6.

33. Regarding claim 57, Eyal fails to teach the continuous media playback, wherein said computer is provided with one or more executable files form said web server to allow said playback manager to adapt said continuous play program with schedules corresponding to different days and sets of days within a year. However, Krikorian teaches the continuous media playback, wherein said computer is provided with one or more executable files form said web server to allow said playback manager to adapt

said continuous play program with schedules corresponding to different days and sets of days within a year (column 6, lines 36-64).

See motivation of claim 6.

34. As per claim 58, Eyal teaches the method of claim 36, wherein said master library contains at least one of digital announcement files and audio files (see col. 11, line 19 – 37, Fig. 22, and col. 38, line 5-9).

35. As per claims 19 and 42, Eyal teaches the continuous media playback system and method of claims 2 and 25, Eyal does not teach wherein said executable files allow said computer to select business hours to operate said playback control device. However, Krikorian teaches wherein said executable files allow said computer to select business hours to operate said playback control device (column6, lines 65-67; column 7, lines 1-6). It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine the teachings of Eyal, Martin and Krikorian. A person of ordinary skill in the art would have been motivated to do this because it would increase system flexibility; thus enhancing user stratification.

36. As per claim 20 and 43, Eyal fails to explicitly teach the continuous media playback of claim 2, wherein said web server is configured to include a password logon security module for accessing said continuous play program. However, Krikorian teaches wherein said web server is configured to include a password logon security

module for accessing said continuous play program (col. 6, line 16 -67; Fig. 4). It would have been obvious for a person having ordinary skill in the art at the time of the invention to add the security of Krikorian to the invention of Eyal in order to prevent unauthorized users from accessing the system.

37. As per claim 22 and 45, Eyal teaches the continuous play broadcast system and method of claims 21 and 25. Eyal does not teach wherein said executable files allow said computer to schedule at least one of said digital announcement files in said continuous play broadcast of said playback control device. Krikorian teaches wherein said executable files allow said computer to schedule at least one of said digital announcement files in said continuous play broadcast of said playback control device (column 6, lines 16-67; Figure 4).

See motivation for claim 19.

38. As per claims 23 and 46, Eyal teaches the continuous media playback system and method of claims 22 and 25. Eyal does not teach wherein said executable files allow said computer to schedule at least one of said digital announcement files and said video files in said continuous play broadcast of said playback control device on a recurring basis. However Krikorian teaches wherein said executable files allow said computer to schedule at least one of said digital announcement files and said video files in said continuous media playback of said playback control device on a recurring basis (column 6, lines 58-64).

See motivation for claim 19.

It is noted that any citation to specific, pages, columns, lines, or figures in the prior art references and any interpretation of the references should not be considered to be limiting in any way. A reference is relevant for all it contains and may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art. In re Heck, 699 F.2d 1331, 1332-33, 216 USPQ 1038, 1039 (Fed. Cir. 1983) (quoting In re Lemelson, 397 F.2d 1006, 1009, 158 USPQ 275, 277 (CCPA 1968))

Conclusion

39. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SAHERA HALIM whose telephone number is (571)272-4003. The examiner can normally be reached on M-F from 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571) 272-4001. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Sahera Halim
Patent Examiner

/ARIO ETIENNE/
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